



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,898	03/22/2004	Michael H.B. Stowell	00-356-D	1941

7590 08/20/2009
McDonnell Boehnen Hulbert & Berghoff LLP
32nd Floor
300 S. Wacker Drive
Chicago, IL 60606

EXAMINER

AKRAM, IMRAN

ART UNIT	PAPER NUMBER
----------	--------------

1795

MAIL DATE	DELIVERY MODE
-----------	---------------

08/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,898	Applicant(s) STOWELL, MICHAEL H.B.	
	Examiner IMRAN AKRAM	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-23 is/are pending in the application.
- 4a) Of the above claim(s) 3,7-9,13-15 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-6,12,16,17 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/3/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 10-12, filed 6/3/09, with respect to the rejection(s) of claim(s) 2, 4-6, 10-12, 16, 17, and 21-23 under Anderson in view of Rock have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the same references, but with a more thorough evaluation of their combination and motivation to combine.
2. Applicant argues on page 10 that the previous office action neglects to consider the differences between the prior art and the instant claims, on page 11 that the Examiner neglects to provide proper motivation for combining the references, and on page 12 that the Examiner uses improper hindsight reasoning. Examiner agrees with these assertions. However, Examiner still believes the claims to be unpatentable over the combination of these same two references for the reasons submitted below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1795

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2, 4-6, 10-12, 16, 17, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rock (US 6,022,529) in view of Anderson (US 6,437,150 B1).

6. Rock discloses a chemical structure identical to the species being examined without the fragrance molecule as well as a carrier for topical administration (see claim 3). Rock does not, however, disclose a fragrance molecule at the R1 group.

7. Anderson is an invention that discloses the use of molecules that undergo photochemical transformation to emit a smell. These molecules contain fragrance precursors (column 7, lines 1-15) and are to be used in topical creams and sprays for human hygiene products (column 12, lines 58-67). One such fragrance molecule is what Anderson refers to as an organoleptic alcohol (see molecule 4 in column 5). This chain has an aroma and is the product of photo-activation. Anderson teaches this molecule to be attached to a variety of ketones, esters, and other oxygen containing organic compounds. The R1 group of Rock can be an ester or a biomolecule.

Art Unit: 1795

8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the fragrance molecule of Anderson to the precursor group of Rock to impart a fragrance onto the compound of Rock. As shown in Anderson, the fragrance molecule is capable of being a product of photochemical rearrangement. Since Rock is to be used with fragrances (column 5, lines 50-58), it would then be obvious to impart the same advantages taught by both Rock and Anderson--namely, to provide advantage from photochemical rearrangement--to combine the references.

9. In regards to claim 5 and 6 specifically, Anderson discloses an auxiliary fragrance (column 7, lines 18-25) and column 5 reveals that the original molecule will photorearrange to become a fragrance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMRAN AKRAM whose telephone number is (571)270-3241. The examiner can normally be reached on 10-7 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA
/Jennifer K. Michener/
Supervisory Patent Examiner, Art Unit 1795